



3750
Docket No.: A8130.0088/P088-B
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jeffrey M. Whelan

Application No.: 10/824,603

Group Art Unit: 3731

Filed: April 15, 2004

Examiner: D. Reip

For: METHOD OF LOADING TENDONS
INTO THE KNEE

INFORMATION DISCLOSURE STATEMENT (IDS)

Commissioner for Patents
Washington, DC 20231

Dear Sir:

Pursuant to 37 CFR 1.56 and MPEP 2001.06(c), applicant hereby notifies the Patent and Trademark Office that the subject matter for which a patent is presently being sought is currently involved in litigation, specifically Arthrex, Inc. v. Depuy Mitek, Inc., Civil Action No. 2:04-cv-328-FTM-33DNF, pending in the U.S. District Court for the Middle District of Florida.

In the above-referenced litigation, Depuy Mitek, Inc., the defendant and alleged infringer, asserts that the parent patent, U.S. Patent No. 6,733,529, is, *inter alia*, “invalid under 35 U.S.C. §§ 102/103 and 112” (Amended Answer, ¶ 12), “invalid for failing to name the proper inventors” (Amended Answer, ¶ 13), and “unenforceable due to inequitable conduct committed . . . during the prosecution of the ‘529 patent and related patents.” (Amended Answer, ¶¶ 14-25). A copy of the Amended Answer filed by Depuy Mitek is attached.

The plethora of invalidity/unenforceability contentions propounded by Depuy Mitek, Inc. in its shotgun-type attack on the ‘529 patent are wholly baseless and indeed are premised upon false assumptions. For example, in the Amended Answer, ¶¶ 21-22, with

regard to its charge of inequitable conduct, Depuy Mitek contends that “a reasonable Examiner would have considered Dr. Goble’s testimony [set forth in the Goble Declaration] important in assessing the patentability of the 529 patent.” A copy of the Goble Declaration is attached hereto. **Notably, all prior art patents and publications (i.e., *the factual evidence*) cited and relied upon by Dr. Goble in his declaration were cited by applicant to the Examiner in an Information Disclosure Statement in the then pending patent application, and have since been cited and made of record in each subsequent continuation application, including the present application.**

In reaching his own *conclusion* in his Declaration that the claims of the ‘604 patent would have been obvious, Dr. Goble relies upon his own patent, U.S. Patent No. 5,431,651 as a primary reference. Notably, however, this patent, the Goble ‘651 patent, had been previously cited by the applicant and relied upon by the Examiner in § 102(b) rejection set forth in an Office Action (copy attached) mailed on September 2, 1998 during the prosecution of the application for the ‘604 patent. This rejection was successfully overcome by way of an Amendment (copy attached) filed on October 26, 1998. In particular, applicant stated as follows in the remarks accompanying the October 26, 1998 Amendment:

In contrast to the present invention as recited in amended claim 1, however, Goble ‘651 does not disclose or suggest engaging a graft with a flexible strand pulled out through the entrance to the socket, and pulling the flexible strand and the attached graft into the socket. Accordingly, Goble ‘651 does not anticipate or render obvious the present invention as recited in amended claim 1.

In response to the above Amendment and remarks, the Examiner issued a Notice of Allowance on December 16, 1998. For like reasons, the claims of all subsequent continuation applications, including the present application, are clearly distinguishable over Goble ‘651 -- namely, Goble ‘651 does not teach or suggest looping a graft over the looped portion of a transversely positioned flexible strand extending outside of the tibial tunnel, and then pulling the loop of the graft through the tibial tunnel and into an opening in the femur, where it is subsequently secured with a transverse implant.

Even though applicant strongly submits and believes that neither the Patent Office rules nor the MPEP require an applicant to submit the *contentions and conclusions* of an opposing litigant (as opposed to *factual evidence* which may be material to examination, which, as stated above, has already been made of record in all continuation applications, including the present continuation application), Depuy Mitek insists in its pleadings that this information should have been submitted. Accordingly, to placate Depuy Mitek, applicant has now submitted Depuy Mitek's contentions in its Amended Answer (which reference and reiterate Innovasive Devices' contentions). Indeed, applicant has gone one step further by providing the Examiner with a copy of the Goble Declaration (which, like Depuy Mitek's and Innovasive Devices' pleadings, contains Dr. Goble's *conclusions and opinions*). Applicant, of course, is happy to supply the Examiner, upon request, with any or all of the numerous other declarations, briefs and pleadings filed in the Innovasive Devices litigation and in the current litigation with Depuy Mitek. Applicant reiterates, however, that all *facts* material to the patentability of the claimed subject matter (i.e., the patents and printed publications at issue) are already of record.

The attached documents are listed on the attached PTO/SB/08. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the documents be made of record therein and appear among the "References Cited" on any patent to issue therefrom. For reasons stated above, the submission of the attached information is not intended to constitute an admission that any information referred to therein is "material" or constitutes "prior art" for this invention. Indeed, as set forth above, applicant submits that the information is immaterial.

In accordance with 37 CFR 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR 1.56(a) exists. It is submitted that the Information Disclosure Statement is in compliance with 37 CFR 1.98 and the Examiner is respectfully requested to consider the listed references.

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The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1073, under Order No. A8130.0088/088-B.

Dated: November 15, 2004

Respectfully submitted,

By 

Stephen A. Soffen

Registration No.: 31,063

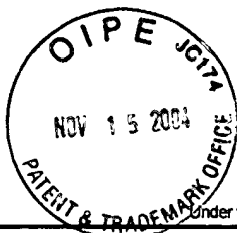
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PTO/SB/08a/b (08-03)

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Substitute for form 1449A/B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)				Complete if Known	
				Application Number	10/824,603-Conf. #6410
				Filing Date	April 15, 2004
				First Named Inventor	Jeffery M. Whelan
				Art Unit	3731
				Examiner Name	D. Reip
Sheet	1	of	1	Attorney Docket Number	A8130.0088/P088-B

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		DePuy Mitek Inc's Amended Answer to Arthrex's Complaint & Counterclaim, filed October 14, 2004, Civil Action No. 2:04-cv-328-FTM-33DNF (M.D. FL).	
		Declaration of E. Marlowe Goble in Support of Innovasive Devices, Inc's Opposition to Arthrex's Motion for Partial Summary Judgment (with Exhibits A, B and C), October 14, 1999, Case No. 99-851-CIV-ORL-18C (M.D. FL).	
		Office Action, Serial No. 09/015,618, mailed September 2, 1998.	
		Response to Office Action, Serial No. 09/015,618, filed October 26, 1998.	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
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